



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,845	01/16/2004	Henry Gene Ramirez	FAS-003-US	6940
31955 7590 03/17/2008 ROSENFELD LAW CORPORATION 1638 FILBERT STREET SAN FRANCISCO, CA 94123				
EXAMINER				
KNOX, STEWART				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/758,845

**Applicant(s)**

RAMIREZ ET AL.

**Examiner**

STEWART T. KNOX

**Art Unit**

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 4-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CIS)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification contains no antecedent basis for the limitation “wherein the length of the case section is dependent upon water weight volume of the cartridge case, the bore diameter of the gun barrel, and the weight of the bullet.” In particular, it is noted that this limitation relates to the length of the case section, whereas the limitation in claims 5 and 10 relate to an overall range of values that those variables contain. In the remarks/arguments filed 1/22/2007, Applicant responded by citing several portions of the specification which relate to the material of claims 5 and 10, not 4 and 9. The cited portion, in fact, appears to contradict the claim – “Based on a desired bullet weight and cartridge length, the bore diameter is then determined (page 7 of 10). There is no indication in the formula used for how any of this relates to cartridge length.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. In particular, the last limitation of claim 4 states, “the length of the case section is dependent upon water weight volume of the casing, the bore diameter of the gun barrel, and the weight of the bullet.” There is no indication, in the specification or claims, as to how it depends on these variables, and further, what value might be specified by these variables. As such it is indefinite.

3. Furthermore, no actual cartridge case is positively claimed. Thus any limitations on the water weight volume, bore diameter of the mouth, or the weight of the bullet are irrelevant except to define what the gun chamber is capable of use with (as it applies to claims 4, 5, 9, and 10).
4. Although this rejection was previously withdrawn, it was withdrawn in error because of the other 112 rejection that was resolved.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 4-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,532,876 and claims 1-2 of U.S. Patent No. 6,679,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to corresponding components (or methods therefore) defined in exactly the same manner. The gun cartridge and gun chamber must be built to fit one another, and both sets of claims define the same sets of measurements -- the older patent thus fully implies the claims of the present invention. Additionally, claim 4 of the present invention is broader than claim 1 of the '876 patent in that it does not specify case length or shoulder angle.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamison (5,970,879).
3. Jamison discloses a gun chamber (figure 2 element 16) for use with a gun action and barrel and configured for accepting a gun cartridge having a proximal and distal end for propelling a bullet of a pre-determined weight, the gun chamber having a case section (near the element number 16) proximal to the gun action and configured for housing a cartridge case, a free bore section (41) proximal to the barrel and distal end of the cartridge case, a shoulder section (angled section to the left of element 40 in figure 2A) at the proximal end angling inward from the case section, a neck portion (terminating in element 40) located between the shoulder section and the free bore section wherein the neck portion is configured for accepting a cartridge having a mouth for accepting a bullet, wherein the length of the case section is inherently dependent upon water weight volume of the cartridge case, the bore diameter of the gun barrel, and the weight of the bullet. Jamison further discloses that the shoulder section angles inward at an angle of 30 degrees (col. 6 line 18), and a sum of the case section, shoulder section, neck section, and free bore section having a maximum total length of 4.0 inches (col. 4 lines 12-13, where the value as described in the claim is equal to L plus the section 41. L can be calculated to be max at 2.35, and the section 41 is very small relative to that amount, so it does not exceed 4.0

inches total). Further, the case section has a length (L) of between 1.9 and 2.5 inches, as shown above. Jamison does not disclose a 50-caliber cartridge with the measurements and ranges as claimed (discussed below).

4. Jamison discloses the claimed invention except for that the cartridge is a 50-caliber gun cartridge with a diameter of approximately 0.668 inches at the distal end and a mouth with a bore diameter of approximately .510 inches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide those values for a 50-caliber cartridge, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Additionally, under *KSR International Co. v. Teleflex Inc.*, it would be "obvious to try" to achieve the same design on differently-sized gun cartridges and, given the small variation in size that such a modification would entail, one of ordinary skill in the art could have pursued the 50 caliber option with a reasonable expectation of success.

5. Jamison discloses the claimed invention except for the water weight volume of the casing in grains multiplied by the bore diameter of the mouth in thousandths of an inch divided by the weight of the bullet in grains is greater than or equal to 110 and less than or equal to 145. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the bullet properties in that range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Response to Arguments***

6. Applicant's arguments filed 1/9/2008 have been fully considered but they are not persuasive.
7. First, Applicant disagrees with the Office's assertion that the length of the case section is inherently dependent upon the water weight volume of the case, bore diameter of the barrel, and weight of the bullet, noting that Jamison discloses a dependence on a length over diameter ratio.
8. In response, it is first noted that changing the length or diameter of the bullet would necessitate changing the dimensions of the case section. Thus the dimensions are certainly related. Further, changing the length or diameter would necessitate changing one of the water weight volume, the bore diameter, and the weight of the bullet. The relation claimed is thus inherent because a relation such as this can be derived for any given bullet and any given gun chamber.
9. In other words, depending on the water weight volume of the case (as a function of length and diameter), the bore diameter of the gun barrel (as it relates to bullet diameter and thus case diameter), and the weight of the bullet (again as it relates to other variables discussed above), one would need to select a gun chamber that had dimensions and properties to match these accordingly. Thus it is an inherent property of this and every bullet and gun chamber combination.
10. Further, the notion of "utilizing weight in determination of cartridge length," as discussed by applicant at the top of page 7, is both an intended use limitation and a product-by-process limitation. The independent claims, in both the apparatus and the method, relate to a gun chamber and do not positively recite a cartridge. Instead, they merely recite that the length of



one of the sections of the gun chamber are dependent on the properties of a hypothetical cartridge.

11. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed projectile or the **Product by Process** Claims, applicant is direct to MPEP § 2113 cited in the prior office action. Therefore the case section length being formed with water weight volume, bore diameter, and bullet weight in mind is not pertinent in this instance to the patentability of this product claim.

12. Finally, Applicant argues that Jamison does not disclose a 50 caliber cartridge (as acknowledged by the Examiner) and that Jamison is therefore not acceptable prior art. In response, however, it is noted that the Examiner’s rejection relied upon the obviousness of changing dimensions in order to suit other purposes, especially when the dimensions in question are “standard” dimensions for known cartridge sizes. Additionally, under *KSR International Co. v. Teleflex Inc.*, it would be “obvious to try” to achieve the same design on differently-sized gun cartridges and, given the small variation in size that such a modification would entail, one of ordinary skill in the art could have pursued the 50 caliber option with a reasonable expectation of success.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stewart T. Knox whose telephone number is (571) 272-8235. The examiner can normally be reached on Monday through Thursday, 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (571) 272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stewart Knox/

/Michael J. Carone/  
Supervisory Patent Examiner, Art Unit 3640